IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	**MAIL STOP AF**
Bradford G. Baruh	Group Art Unit: **3679**
Application No.: 10/779,471	Examiner: AARON M. DUNWOODY
Filing Date: February 13, 2004	Confirmation No.: 5526
Title: DEVICE AND METHOD FOR COUPLING PIPES	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection dated August 24, 2010, rejecting Claims 1-6, 11, and 23-36. No amendments are being filed with this Request. Reconsideration and allowance are respectfully requested in view of the following remarks. This request is being filed with a notice of appeal.

A. Overview

1. Claims 1, 11, 23, 29, 30 and 36 were rejected under 35 U.S.C. 102(b) as allegedly anticipated by JP 01-182694, Ezaki et al. (hereinafter "Ezaki").

2. Claims 2-6, 24-28, 31 and 32 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Ezaki et al. (hereinafter "Ezaki) in view of U.S. Patent No. 3,995,888, McIlroy (hereinafter "McIlroy").

B. Claims 1, 11, 23, 29, 30 and 36 are patentable over Ezaki, since Ezaki does not disclose the existence of an elongated housing or bore therein as recited in Claims 1, 11, and 23

Claims 1, 11, 23, 29, 30, and 36 were rejected under 35 U.S.C. 102(b) as allegedly anticipated by JP 01-182694, Ezaki et al. (hereinafter "Ezaki").

Claims 1, 11, and 23 recite among other elements a pipe coupling, which includes an elongated housing comprising a first end and a second end, the housing defining an elongated bore therein, a stop located on an inner diameter of the housing, the stop located between the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing.

Ezaki relates a pipe fitting, wherein "[e]ach of butting end faces 101, 102 of pipe bodies 1, 2 is formed into an almost circular incline with angles θ1, θ2 to virtual cutting planes (A), (B) perpendicular to respective axes 01, 02. Accordingly, these butting end faces 101, 201 as each rotational surface whereby each connected angle of these pipe bodies 1, 2 can be variably adjusted." (See English Abstract of Ezaki).

Ezaki does not disclose the existence of an elongated housing or elongated bore therein as recited in Claims 1, 11, and 23. Elongate or elongated refers to "1: stretched out 2: slender" Merriam-Webster's Collegiate Dictionary, Tenth Edition. On the contrary, Ezaki relates to a pipe fitting, which has approximately the same diameter (or width) as length. Furthermore, if the pipe fitting of Ezaki had an elongated housing as recited in Claims 1, 11, and 23, the pipe fitting of Ezaki would be unable "[t]o make the connected angle of a pipe body variably adjustable in an easy manner by forming each of butting end faces of the pipe body into an almost circular inclined angled with a virtual cutting plane perpendicular to the axis" as described in the English Abstract of Ezaki.

In addition, as recited in Claims 1 and 11, Ezaki does not teach or disclose that each of the cylindrical bores are configured to allow a pipe end to advance into the pipe coupling until reaching the stop. Rather, as shown in FIGS. 1 and 7 of Ezaki, a pipe end would be free to extend through the stop rather than advancing into the pipe coupling until reaching the stop as recited in Claims 1 and 11.

Accordingly, for the reasons set forth above, Claims 1, 11 and 23 should be allowable. Claims 29, 30 and 36 are dependent from Claims 1, 11, and 23, and for the reasons set forth above as to Claims 1, 11, and 23, Claims 29, 30, and 36 should be allowable.

C. Claims 2-6, 24-28, 31, and 32 should be allowable over Ezaki in view of McIlroy since Ezaki does not disclose the existence of an elongated housing or bore therein as set forth above

Claims 2-6, 24-28, 31, and 32 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Ezaki et al. in view of U.S. Patent No. 3,995,888, McIlroy (hereinafter "McIlroy").

According to the Examination Guidelines for Determining Obviousness, 72 Fed. Reg. 57526, 57528 (Oct. 10, 2007), Office personnel must resolve the Graham factual inquiries and then articulate the following:

> (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
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> (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;
>
> (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and
>
> (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. *Id.*

In *Ex Parte Whalen*, 89 USPQ2d 1078 (BPAI 2008), the Board articulated that "obviousness cannot be proven merely showing that the elements of a claimed device were known in the prior art" (emphasis added). The Board stated that to demonstrate obviousness, "it must be shown that those of ordinary skill in the art would have had some 'apparent reason to combine the known elements in the fashioned claimed.'" *Id.* (quoting *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007)) (emphasis added).

The Official Action takes the position that Ezaki discloses the claimed invention except for the angle between the first cylindrical bore and the second cylindrical bore being about 45, 60, 90, 120, 135 degrees. Acknowledging that Ezaki fails to disclose the respective angles, McIlroy is cited for disclosure of "angles (acute and obtuse) between a first cylindrical bore and a second cylindrical bore (col. 3, lines 4-7). The Official Action also takes the position that "[i]t would have been

obvious to one having ordinary skill in the art at the time the invention was made to provide an angle between the first cylindrical bore and the second cylindrical bore of about 45, 60, 90, 120, 135 degrees, since such a change is the shape of a prior art device is a design consideration within the level of skill of one skilled in the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)". (See page 5 of the final rejection dated August 24, 2010).

However, the purpose of Ezaki is "[t]o make the connected angle of a pipe body variably adjustable in an easy manner by forming each of butting end faces of the pipe body into an almost circular inclined angled with a virtual cutting plane perpendicular to the axis." Thus, by changing the angle of each of the butting end faces to be about 45, 60, 90, 120, and 135, the variably adjustable function of Ezaki's pipe fitting would not be achieved with an angle of 45, 60, 90, 120 and/or 135 as recited in Claims 2-6 and 24-28, 31 and 32.

Accordingly, for the reasons set forth above as to Claims 1 and 23, and further since Claims 2-6, 24-28, 31, and 32 are dependent from Claims 1 and 23, Claims 2-6, 24-28, 31, and 32 should be allowable.

In view of the foregoing, the panel is requested to withdraw the rejections of record.

Respectfully submitted,

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Date: December 27, 2010

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